

REMARKS

Claims 1-20 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by a patent by Scannell et al. (U.S. Patent No. 5,377,354; hereinafter referred to as “Scannell”). Applicants would like to note the current application is a Continuation-in-part of U.S. Patent No. 6,351,764, in which Scannell was cited and traversed.

Rejections Based Upon Judicially Created Doctrine of Obviousness Double Patenting

Applicants request that the request for a Terminal Disclaimer be put into abeyance until it is determined that there is allowable subject in the current application. Further, it is possible that potential amendments to the claims during prosecution may make the request moot.

Rejections Based Upon 35 U.S.C. §102(b)

With respect to independent claims 1, 12 and 20, the current application is directed at a system that prioritizes messages after filing the message into multiple mailboxes. In contrast, Scannell is directed at first prioritizing mail messages and then filing the messages into mailboxes, in effect basing the prioritization in each mailbox upon the one, original determination of priority. Applicants’ system is able to apply different criteria to each mailbox. The following is an excerpt from Scannell:

A method and apparatus for prioritizing a plurality of incoming electronic mail messages for a user uses a user created and modified rules-control (12) which is stored in a rules-store (12). Incoming messages are stored in a message store (11) and are screened individually by a rules test unit (13). The rules-test unit has a comparator (52) which matches keywords which are chosen by the user while creating the rules, add supplies signals to an action list unit (54). By applying the user created rules for deciding which messages constitute the priority messages for the user, a priority assigning unit (45) within an action portion (35B) of the rules-store (12) assigns a priority number (say from 1 to 5, 1 being the highest priority for example) to each screened message. Responsive to the assigned priority number of the screened message, the message is sent to a main folder store or forwarded or put away as appropriate.

(Scannell, Abstract). Scannell nowhere discloses sorting and depositing the e-mail messages into a plurality of virtual mailboxes wherein the e-mail message is prioritized within such virtual mailboxes based upon the assigned code. Rather, Scannell teaches the use of one main “in tray” (col. 8, lines 14-15). Nor does Scannell teach the prioritization of messages in each mailbox (see col. 6, lines 14-17). In other words, Scannell does not teach or suggest prioritizing within mailboxes. In fact, Scannell treats “prioritization” and “filing” as distinct and separate operations. Thus, Scannell teaches an invention with an “in tray” and supplemental folders that are separate and distinct from the “in tray” and that do not perform sorting functions. In contrast, the present invention employs a plurality of mailboxes, each of which may have sorting and/or prioritization functionality.

In order to reject a claimed invention under §102(e), the cited reference must teach every aspect of the claimed invention either explicitly or impliedly. (M.P.E.P. §706.02). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (M.P.E.P., §2143,03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, “All words in a claim must be considered in judging the patentability of that claim against prior art.” (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970)).

In addition, claims 2-11 and 13-19 are allowable as being dependent upon allowable base claims and Applicants also respectfully request allowance of these claims as well.

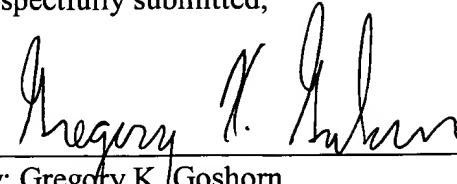
CONCLUSION

It is respectfully submitted that all issues and rejections have been adequately addressed and that pending claims 1-20 are allowable and that the case should be advanced to issuance. Although fees are being submitted with respect to this amendment, if there are additional fees associated with this filing, the Commissioner is hereby authorized to charge or credit any overpayment to the deposit account of Hulsey, Grether, Fortkort & Webster, LLP, Deposit Account No. 50-2726.

If the Examiner has any questions or wishes to discuss the claims, the Examiner is encouraged to call the undersigned at the telephone number indicated below.

Via Express Mail Label EV 367516338 US
Date of Mailing: July 15, 2004

Respectfully submitted,



By: Gregory K. Goshorn
Reg. No.: 44,721
ATTORNEY FOR APPLICANT

Date: July 15, 2004

Hulsey Grether + Fortkort, LLP
8911 N. Capital of Texas Hwy., Suite 3200
Austin, Texas 78759
Telephone: (512) 279-3106
Facsimile: (512) 279-3101